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IN THE

Supreme Court of the United States

October Term, 1943.

No. 455

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LEROY J. LEISHMAN,

Petitioner,

vs.

ASSOCIATED WHOLESALE ELECTRIC COMPANY, a corporation,

Respondent.

Petition for Writ of Certiorari and Brief in Support Thereof.

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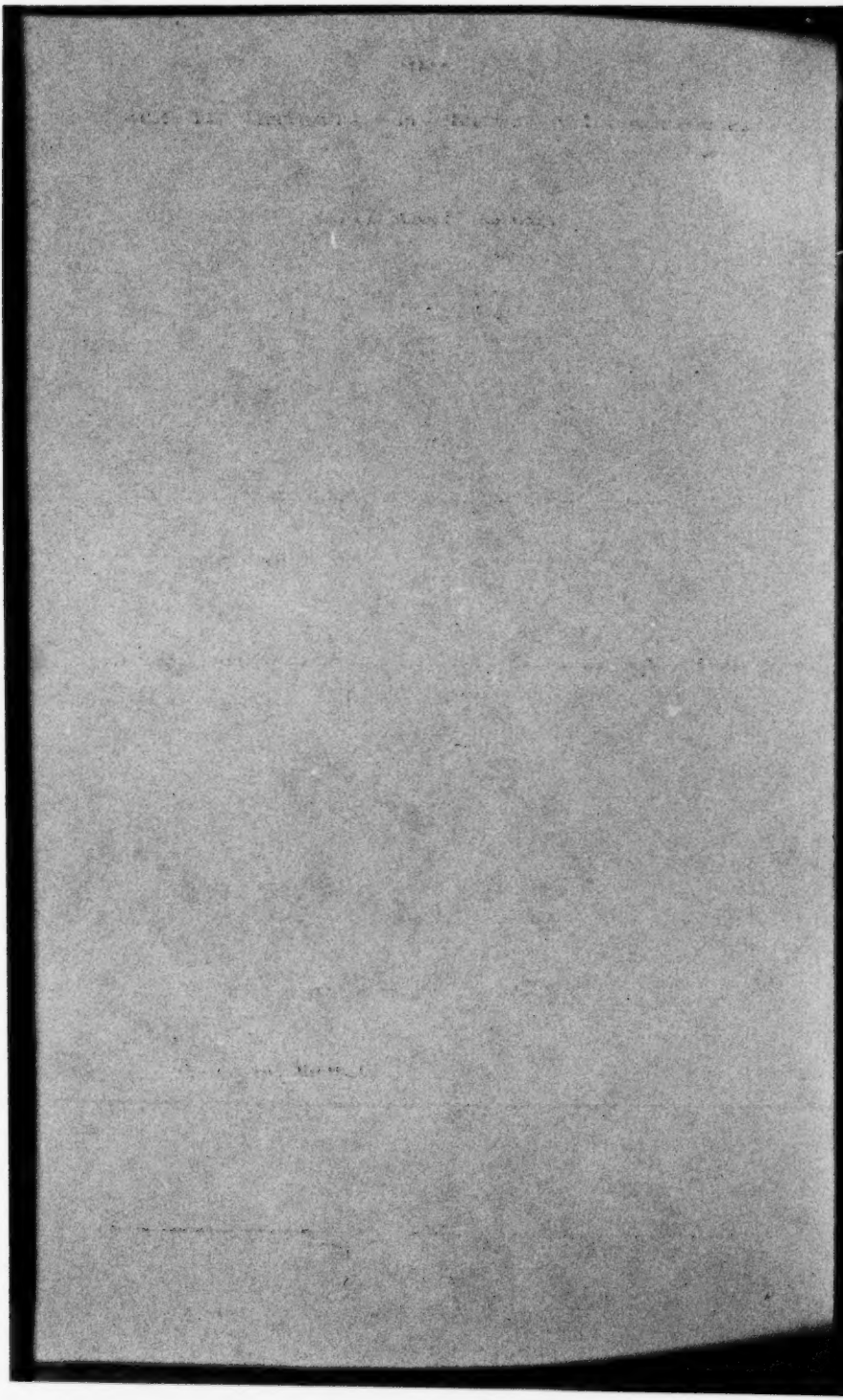

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LEROY J. LEISHMAN,

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vs.

ASSOCIATED WHOLESALE ELECTRIC COMPANY, a corporation,

Respondent.

PETITION FOR WRIT OF CERTIORARI.

To the Honorable Supreme Court of the United States:

Your petitioner respectfully shows:

Statement of the Matter Involved.

LeRoy J. Leishman, petitioner herein, brought this suit in the United States District Court for the Southern District of California, against Associated Wholesale Electric Company, a corporation, respondent herein.

The petitioner alleged that respondent infringed Reissue Letters Patent No. 20,827 [R. Vol. I, pp. 2 *et seq*].

The respondent, among other defenses, urged that the claims at issue were invalid for want of invention; that the reissue patent was invalid because it was granted for an invention other than that secured by the original patent;

and that the respondent did not infringe the claims at issue. These defenses were set out in the respondent's answer [R. Vol. I, pp. 6 *et seq.*].

After a trial, a final judgment was entered, dismissing the complaint on the ground that the claims at issue were invalid for want of invention [R. Vol. I, pp. 38 *et seq.*].

An appeal was taken from the judgment, which the Circuit Court of Appeals dismissed on May 26, 1942 [R. Vol. IV, pp. 688, 689], on the ground that the appeal was not taken in time. A petition for a writ of certiorari was granted by this Honorable Court on October 12, 1942 [R. Vol. IV, p. 692]. On February 15, 1943, this Honorable Court reversed the decision of the Circuit Court of Appeals [R. Vol. V, p. 695]; and on August 12, 1943, the Circuit Court of Appeals rendered its opinion on the merits of the case. In that opinion, the judgment of the District Court was modified, and dismissal of the complaint was affirmed [R. Vol. V, p. 717]. As will be pointed out hereinafter, that opinion is in conflict with that in *Monogram Mfg. Co. v. Glemby Co., Inc., et al.*, 136 F. (2d) 961, and with former opinions of this Court.

The reissue patent in suit [R. Vol. III, pp. 508 *et seq.*], like the original patent [R. Vol. III, pp. 514 *et seq.*] as stated in the objects, relates to a mechanism for tuning "either a radio set or a television set, or both," "by a simple manually operated control." This is accomplished in such manner that, when a force is applied to the manual operating member, the mechanism finally reaches and maintains a position that corresponds to a tuned-in position for a selected transmitting station, or, if both radio and television are involved, for a pair of such stations. The operation of the mechanism is readily understood from an in-

spection of Figs. L-1 to L-5, inclusive, of Plaintiff's Exhibit 24 [R. Vol. III, p. 536]. A lever F is shown as the manually movable operating member. It carries a tappet 61, referred to as a positioning element, that co-operates with a rocker 48 carried by a shaft S that is connected to the tuning condenser.

Downward movement of lever F causes the tappet 61 to urge the rocker 48 to a definite angular position, corresponding to the adjusted position of the tappet (Fig. L-5). Further movement of the lever F and rocker 48 is arrested by the complete engagement of the tappet arms with both sides of the rocker.

The original patent contained five relatively narrow claims directed to the double use of the invention requiring two tappets and rockers, and in which the manual operating means for bringing the tappet into engagement with the rocker was referred to as a lever; and it contained a broad claim (claim 5, which was later disclaimed from the reissue) directed to a single tappet and rocker, and this claim did not even include the operating means as an element of the combination.

Claim 5 of the original patent read as follows (the parts of the device being referred to parenthetically for the convenience of this Court by the reference numerals used in the patent):

> "5. The combination with the tuning mechanism of a radio apparatus; of a rotatable rocker (48) mounted upon a shaft (S) operatively connected with said mechanism, said rocker having two arms each extending on a different side of said shaft; means (the tappet 61) movable about a pivot (60) and acting upon operation in one direction to slidably engage either arm of said rocker and push it in one direction

to an angular position at which the movement of said rocker is arrested by the collision of said means and the oppositely moving other arm of said rocker; and a spring for holding said means in a normally inoperative position."

Because the kind of means for bringing the tappet into engagement with the rocker is immaterial to the invention, this claim was confined to the essential elements—the rocker, the tappet, and a spring acting to hold the tappet normally away from the rocker.

The reissue patent contained all the claims of the original, including claim 5, and added claims 7, 8, 9, 10, 11 and 12, patterned after claim 5, but having various limitations and qualifications directed chiefly to structural features of the rocker and tappet and their specific coaction, as disclosed in the original specification and drawings.

Claims 7 and 8, like claim 5, do not call for a lever nor anything that can even be construed as an equivalent.

Regarding the rocker and tappet, the Court of Appeals says [R. Vol. V, p. 715]: "The accused device * * * has a rocker which is the equivalent of appellant's rocker 48. * * * It has tappets each of which is the equivalent of appellant's tappet 61." And the accused device also contains the spring. All the elements of claims 7 and 8 are thus present, each acting in the manner disclosed, illustrated and claimed. The hitherto accepted requirements for infringement were thus fully met and, moreover, recognized by the Circuit Court.

The District Court had previously said [R. Vol. I, p. 22]:

". . . it cannot be seriously denied that the accused device uses the rotatable rocker, adjustable

> tappet and when brought to rest the two parts are coaxial—*the essential elements contained in the plaintiff's structure.*" (Emphasis added.)

And on page 26, Vol. I, the trial court reiterated: ". . . as I have stated before, it contained plaintiff's combination."

However, the Circuit Court of Appeals in considering the combination covered by the claims at issue, refers to *U. S. Industrial Chemicals, Inc., v. Carbide & Carbon Chemicals Corporation,* 315 U. S. 668, as authority for the unwarranted statement that if claims 7-11 of the reissue patent "do not include levers, the claims are not for the same invention as the original patent and hence are invalid. If they do include levers, the claims are not infringed, for the accused device contains no lever" [R. Vol. V, p. 715].

In formulating this hypothesis, the Circuit Court of Appeals for the Ninth Circuit reiterated the well established principle that a reissue patent must be for the same invention as the original patent [R. Vol. V, p. 702]. The Court then [R. Vol. V, p. 703] propounded the following:

> "Hence the questions here to be considered are whether what is covered by claims 7-11 of the reissue patent was disclosed in the original patent, and whether it appears from the face of the original that what is covered by claims 7-11 of the reissue was intended to have been covered and secured by the original."

The Circuit Court of Appeals [R. Vol. V, pp. 714 *et seq.*] proposes to determine this intent of the petitioner by interpreting the claims of the original patent, despite the obvious fact that it would be pointless to reissue a

patent if the original claims had to be adhered to. That Court points out that all of the original claims mention a lever; but in doing so it had to ignore original claim 5, which it did by misapplication of *Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U. S. 477, 491 [R. Vol. V, p. 702]. The Court does this in the following manner [R. Vol. V, p. 701]:

> "* * * On January 16, 1939, while the action was pending in the District Court, claim 5 was disclaimed in its entirety. Hence both the original patent and the reissue must be construed as if claim 5 had never been included in either (here footnote 6 cites *Dunbar v. Myers*, 94 U. S. 187, 194; *Schwarzwalder v. New York Filter Co.*, 2 Cir., 66 F. 152, 158; *Oliver Machinery Co. v. Gellman*, 6 Cir., 104 F. (2d) 11, 12); for the disclaimer 'speaks from the date of the original patent.'" (Here footnote 7 cites *Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U. S. 477, 491.)

When quoting the original claims for determining intent, and omitting claim 5 entirely from such quotation, the Court in footnote 12 [R. Vol. V, p. 709] further explains: "For reasons heretofore stated, the patent is construed as if claim 5 had never been included therein." In other words, the patent is artificially construed as if it never had described or claimed a combination in which the lever was not included as an element.

Because of this improper application of the decision in *Altoona Publix Theatres v. American Tri-Ergon Corp.*, the Court finds justification for its statement that ". . . nor does it appear from the face thereof that any leverless combination was intended to have been covered or secured thereby." [R. Vol. V, p. 712.]

Since the Court (without considering claim 5 or weighing the objects) thus justifies its interpretation of the invention secured by claims 7-11 as one that necessarily includes a lever, it accordingly comes to its ultimate conclusion that the plunger operated accused device is outside the scope of these claims.

The Supreme Court Has Jurisdiction to Review the Appellate Court's Decision.

Petitioner relies upon Section 240 of the Judicial Code, corresponding to Title 28, U. S. C. A., paragraph 347. There is a conflict in the decision herein sought to be reviewed, and in that of Circuit Court of Appeals for the Second Circuit, in *Monogram Mfg. Co. v. Glemby Co., Inc., et al.*, 136 F. (2d) 961. Furthermore, the decision herein sought to be reviewed is inconsistent with *Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U. S. 477, and with *U. S. Industrial Chemicals, Inc., v. Carbide & Carbon Chemicals Corporation*, 315 U. S. 668, in that these decisions have been misinterpreted by the Circuit Court of Appeals in this case.

The Questions Presented.

The real import of the decision of the Ninth Circuit Court is that a reissue patent is not for the same invention as the original unless its added claims include every element mentioned in any and all of the original claims, and identified by the same terms as in the original; and it held to that effect in the instant case even though one of the elements was not stressed in the original as essential to the invention *per se;* and notwithstanding the fact that the original patent contained a claim which did not include this particular element in the combination at all.

Though the Court cites the Supreme Court opinion in the *U. S. Industrial Chemicals* case as authority for the decision complained of, petitioner believes the cited Supreme Court opinion has been misapplied in the present case and that this Honorable Court never intended that its opinion in the *U. S. Industrial Chemicals* case would be construed to mean that reissue claims must not omit any element mentioned in the original claims even if such element was not described as essential.

Faced with a set of facts parallel to those in the instant case, the Second Circuit Court of Appeals ruled that it was not necessary for reissue claims to include an element not stressed in the original as essential, and, after citing the Supreme Court decision in the *U. S. Industrial Chemicals* case in support of its holding, it differentiated the facts in the Second Circuit case from those considered by the Supreme Court in its *U. S. Industrial Chemicals* opinion by stating (136 F. (2d), p. 964):

> "It may be noted that in the Industrial Chemicals case, the element omitted from the issue therefore held invalid was considered essential to the invention by the patentee himself and by the trade generally. That it was dispensable was discovered only by an independent and subsequent experimentation."

One of the questions presented is thus whether or not the Second Circuit or the Ninth Circuit interpretation shall prevail, or, more specifically, whether or not claims added by a reissue must contain every element mentioned in any and all the claims of the original, and identified by terminology that confines each element to the specific embodiment illustrated, in order for the reissue to be for the same

invention—an interpretation which, if permitted to stand, will in large measure nullify the reissue statute and establish a doctrine in conflict with the long accepted practice.

The decision of the appellate court also raises a question as to whether it is permissible, in comparing the original and reissue documents, to omit a claim from the original because such claim was later disclaimed from the reissue.

Petitioner further contends that the Circuit Court of Appeals erroneously interpreted the claims of the reissue patent—an error that leads to freeing the accused device from the charge of infringement.

Another question is presented in that the decision of Ninth Circuit Court is also at variance with the heretofore established principles for determining infringement, for it is clearly an error to hold that a device must include something not mentioned as an element of the combination in a given claim in order to infringe such claim. Such doctrine nullifies the effect of claims altogether.

Petitioner also questions the holding of the Court that the plunger of the accused device is not the equivalent of the lever described in petitioner's patent;[1] on the contrary, petitioner contends that the plunger performs its function of moving the tappet into engagement with the rocker substantially in the same way the lever performs this function. The Circuit Court of Appeals makes the immaterial distinction [R. Vol. V, p. 715, footnote 17] that "Appellant's levers have a double function—that of operating the tappet 61 and that of operating the tappet 62. The latter

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[1]In no case is this holding pertinent to claims 7 and 8, because the manual operating member is not included as an element in these claims.

function is not performed at all in the accused device."[2] Regarding this matter of equivalency, the Court further relies upon its conclusion that petitioner never intended to claim a leverless combination, which, in turn, is based upon an erroneous interpretation of *U. S. Industrial Chemicals, Inc., v. Carbide & Carbon Chemicals Corporation, supra.*

Reasons Relied Upon for Allowance of the Writ.

The Circuit Court of Appeals for the Ninth Circuit has decided an important question of patent law in a way that is in conflict with the decision in *Monogram Mfg. Co. v. Glemby Co., Inc., et al.,* decided by the Circuit Court of Appeals for the Second Circuit, and reported at 136 F. (2d) 961.

This conflict arises from the divergent interpretations of the decision of this Honorable Court in *U. S. Industrial Chemicals, Inc., v. Carbide & Carbon Chemicals Corporation,* 315 U. S. 668. In that case, a step in a chemical process was stressed in the original patent as essential; but, in the reissue, the step was treated as immaterial. On this basis, clearly the requirement prescribed by this Honorable Court that "It must appear from the face of the instrument that what is covered by the reissue was intended to have been covered and secured by the original" was not met.

The Circuit Court of Appeals for the Ninth Circuit in the instant case improperly applies this doctrine in its manner of reaching the conclusion [R. Vol. V, pp. 711, 712]

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[2]This is not a valid distinction, for both the original and reissue patents state that one of the objects is "to make it possible for a single manual operation to tune either a radio set or a television set, or both."

that "No leverless combination is disclosed or claimed in the original patent, nor does it appear from the face thereof that any leverless combination was intended to have been covered or secured thereby." And in so evaluating the intent of the petitioner, the Court failed to give any consideration to two factors: (1) That the objects recited in the original patent do not indicate that the lever *per se* is a necessary element; but on the contrary, each time the operation, or the operating means, is referred to in the objects (which is five times in all), broad terms are used, to wit [R. Vol. V, pp. 703, 704, 705]: "a simple manually operated control," "a single manual operation," "a single manual operation," "a definite manual operation," and "a single manual operation"; and (2) that claim 5 of the original patent did cover a leverless combination, and is clear evidence that petitioner intended to claim such a combination.

The Circuit Court of Appeals for the Second Circuit discussed the doctrine of the *U. S. Industrial Chemicals* case. In this Second Circuit case, the reissue patent disclosed a hair curler that utilized a spring, but this spring, like the lever in the instant case, was not stressed as essential to the invention. In coming to the conclusion that claims omitting the spring were drawn to the same invention as the original patent, the Court states (pp. 963, 964):

> "Defendants contend that the claims of the original patent required a spring between the arms of the curler as a means of clamping the hair and holding it for the winding process, and that the reissue, in adopting all the original claims, but adding several which omitted the spring, was for a different invention. The court below found that Visitacion himself

did not intend any such limitation in the original as that contended for and had so informed his lawyers. That alone cannot be conclusive, since the test must be what was fairly disclosed as essential in the original. This is made clear by the latest case on the subject, United States Industrial Chemicals, Inc., v. Carbide & Carbon Chemicals Corp., 315 U. S. 668, 677, 62 S. Ct. 839, 844, 86 L. Ed. 1105, where the Court said: 'We think it plain that the reissue omitted a step in the process which was described and claimed as essential in the original patent.' Hence, does the original patent here, fairly and reasonably interpreted, describe and claim the spring as an essential part of the curler?

The argument for such a reading is, of course, the obvious fact that the drawings of the original patent do depict, and the specifications describe, such a spring, either as a separate spring wire fitted between the arms of the curler or cut from the shorter arm,[3] and that all of the seven original claims except one describe such a spring as a part of the appliance.[4] But there are several reasons for rejecting so purely literal a reading. First, the patent itself, in three opening paragraphs stressing the objects of the invention, makes no reference in any way to any device requiring a spring.[5] The first paragraph states that 'an object of the invention is to provide an efficient

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[3]So, in the instant Ninth Circuit case, the drawings of the original patent do depict, and the specifications describe, a lever.

[4]So, in the instant case, all except one of the original claims (claim 5) describe a lever as a part of the appliance.

[5]So, in the instant case, the opening paragraphs stressing the objects of the invention, make no reference in any way to any device requiring a lever.

hair curling implement to which the ends of hair strands are secured upon a tubular mandrel, thereafter coiled by winding thereon as closely as possible to the scalp,' and continues to describe the process by which the coils are slipped from the mandrel between the prongs of a bobby pin carried by the mandrel in open position—all without reference to a spring.[6] The second paragraph stresses the easy operation of the instrument, subjected to heat without damage, readily cleansed, capable of long service and of such simplicity as to be inexpensive to construction.

* * * In the light of this background it seems harsh to hold the spring clamp as anything more than at most a 'preferred embodiment.' It may be noted that in the Industrial Chemicals case, the element omitted from the issue therefore held invalid was considered essential to the invention by the patentee himself and by the trade generally. That it was dispensable was discovered only by an independent and subsequent experimentation."

In neither the Ninth or Second Circuit cases, is the disputed element of the combination stressed as essential in the original patent. Yet the Ninth Circuit Court, in evaluating the intent of the patentee and faced with facts parallel to those in the Second Circuit case, comes to a conclusion diametrically opposite to that of the Second Circuit Court. Thus we have two conflicting decisions interpreting the Supreme Court opinion in *U. S. Industrial Chemicals, Inc., v. Carbide & Carbon Chemicals Corporation, supra.*

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[6]In the instant case, the objects mentioned "a simple manually operated control," "a single manual operation" and "a definite manual operation"—all without reference to a lever.

Another reason relied upon for the granting of the petition is that the Circuit Court of Appeals for the Ninth Circuit improperly ignores claim 5 appearing in the original patent. As authority for this, the Court cites *Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U. S. 477, 491, wherein it is briefly stated that a patent amended by disclaimer speaks from the date of the original patent. To interpret this brief statement to mean that a disclaimed claim cannot be considered on the question of intent on the part of the patentee is clearly contrary to the meaning of that Supreme Court case.

To hold that a claim of the original patent which has been deleted from the reissue is not to be taken into consideration in determining what the patent reveals on its face and what the patentee sought to cover, is a holding that is totally without precedent; and it involves a point of law, in addition to the question already posed, on which this Honorable Court has never passed, but which this Honorable Court should review because of its far reaching effect upon future reissue patents as well as upon those already granted and now in force.

Prayer for the Issuance of the Writ.

Wherefore, your petitioner prays that a writ of certiorari issue under the seal of this Court, directed to the United States Circuit Court of Appeals for the Ninth Circuit, commanding said Court to certify and send to this Court a full and complete transcript of the record and of the proceedings of the said Circuit Court had in the case numbered and entitled on its Docket No. 9970, LeRoy J. Leishman, appellant, vs. Associated Wholesale Electric Company, a corporation, appellee, to the end that this cause may be reviewed and determined by this Court as provided by the statutes of the United States; and that the judgment herein of said Circuit Court of Appeals for the Ninth Circuit be reversed by the Court, and for such other relief as to this Court may seem proper.

Dated this 18th day of October, 1943.

LeRoy J. Leishman,

By John Flam,

Counsel for Petitioner.

Certificate.

This petition is in my judgment well grounded, and is not interposed for delay.

John Flam.

Counsel for Petitioner.

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LEROY J. LEISHMAN,

Petitioner,

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ASSOCIATED WHOLESALE ELECTRIC COMPANY, a corporation,

Respondent.

BRIEF IN SUPPORT OF PETITION.

I.

Publication of Opinions of Lower Courts.

The opinion in the District Court [R. Vol. I, pp. 19 *et seq.*] is reported in 36 Fed. Supp. 804.

The first opinion in the Circuit Court of Appeals [R. Vol. IV, pp. 684 *et seq.*] is reported in 128 F. (2d) 204.

The first opinion of the Supreme Court is reported in 63 S. Ct. 543.

The second opinion of the Circuit Court of Appeals [R. Vol. V, pp. 700 *et seq.*] is at this writing yet unreported.

II.

Basis of Jurisdiction.

1. The judgment of the District Court was entered on May 1, 1941 [R. Vol. I, pp. 38 *et seq.*].

2. The decree of the Circuit Court of Appeals to be reviewed was entered on August 12, 1943 [R. Vol. V, pp. 717 *et seq.*].

3. The statute under which jurisdiction is invoked is Section 240 of the Judicial Code; 28 U. S. Code, paragraph 347.

4. The United States Circuit Court of Appeals for the Ninth Circuit applied the reasoning of *U. S. Industrial Chemicals, Inc., v. Carbide & Carbon Chemicals Corporation, supra,* in a manner that conflicts with the Circuit Court of Appeals for the Second Circuit, in *Monogram Mfg. Co. v. Glemby Co., Inc., et al., supra.*

5. The Circuit Court of Appeals for the Ninth Circuit has ruled in a manner inconsistent with *U. S. Industrial Chemicals, Inc., v. Carbide & Carbon Chemicals Corporation, supra.*

6. The Circuit Court of Appeals for the Ninth Circuit has also misapplied the decision in *Altoona Publix Theatres v. American Tri-Ergon Corp., supra.*

III.

Statement of the Case.

The case has already been stated in the preceding petition under the heading: "Statement of the Matter Involved," and is hereby adopted and made a part of this brief.

IV.

Specification of Errors.

1. The Circuit Court of Appeals for the Ninth Circuit misapplied the ruling in *U. S. Industrial Chemicals, Inc., v. Carbide & Carbon Chemicals Corporation, supra,* to form a basis for the opinion that the reissue claims 7-11 do not cover a leverless combination.

2. The Circuit Court of Appeals for the Ninth Circuit misapplied the ruling in *Altoona Publix Theatres v. American Tri-Ergon Corp., supra,* to form a basis for its opinion that a disclaimed claim must be ignored when considering the matter of the intent of petitioner to cover a leverless combination.

3. The Circuit Court of Appeals for the Ninth Circuit erred in interpreting claims 7 and 8, as necessarily including a lever, although the combination defined in these claims does not include any element that could even be construed as the equivalent of the lever.

V.

Argument.

That a conflict in the decisions of two Circuit Courts of Appeals forms a sufficient basis for granting this petition is stated in Rule 38, paragraph 5 (b), of this Honorable Court.

In the interpretation of claims of a reissue patent, a serious question is presented. This Honorable Court has held in the *U. S. Industrials* case that, where an element is stressed as essential in the original patent, the reissue claims omitting the step are invalid.

In the instant case, the Ninth Circuit Court of Appeals does not depend at all upon any statement in the original patent that the lever is an essential; nor can it do so, for no such statement can be found in the patent. In fact, many statements in the patent indicate the contrary. Instead, that Court substitutes an incomplete and therefore wrong test—whether or not the *claims* of the original patent included levers.

The Court of Appeals, under its erroneous interpretation of this Honorable Court's decision in the *U. S. Industrial Chemicals* case could have come to a conclusion concerning the validity of the reissue patent. But, instead of so doing, the Court utilizes its erroneous evaluation of what the patentee intended to claim to determine that the accused device does not infringe. The attempted extension of this Honorable Court's decision in the *U. S. Industrial Chemicals* case, to serve as a guide for interpreting the scope of a reissue patent notwithstanding the language of its claims, is clearly unwarranted. All of the reissue claims 7-11 are clearly broad enough to cover a plunger operated device.

The Circuit Court of Appeals had to take two other steps to attempt justification of its decision. One was the holding that claim 5 of the original patent need not be considered on the question of intent to claim an invention. This is an incorrect extension of that branch of the law of disclaimers that is discussed in *Altoona Publix Theatres v. American Tri-Ergon Corp., supra.*

In this latter decision, this Honorable Court considered whether a qualifying disclaimer served to qualify a claim as of the date of the patent, or otherwise. It was held that the claim was qualified as of the date of the patent. In

Dunbar v. Myers, supra, as well as in *Oliver Machinery Co. v. Gellman, supra,* and *Schwarzwalder v. New York Filter Co., supra,* the Court simply pointed out the obvious effect of disclaimers on the construction of the patent in determining the question of infringement. But this certainly is no authority that the claims as written may not be used to determine the intentions of the patentee. And especially is this the case since claim 5 appeared as such in the reissue along with disputed claims 7-11.

If *Altoona Publix Theatres v. American Tri-Ergon Corp.* is to be interpreted to mean that a claim disclaimed from a reissue must be considered for *all* purposes as if it had never been in the original patent, then a claim appearing in the original but *omitted* from a reissue must also be so considered. If original claims omitted from a reissue cannot be taken into consideration in comparing the two documents and in trying to determine the true scope of the invention, then original patents *all* of whose claims have been omitted from the reissue must be considered as having had no scope at all—as being in fact, for inventions that the patents could never cover. If original claims that do not appear identically in the reissue cannot be taken into account at all, then such matters as broadened reissues or narrowed reissues must be done away with, as there will be no basis for determining them.

When properly considered as a part of the original patent, claim 5, which does not include a lever, definitely establishes that petitioner did not consider a lever essential to all embodiments of his invention, and it shows that he realized that the "simple manually operated control" and "the single manual operation" mentioned repeatedly in the objects could be effected by any suitable means.

The Circuit Court of Appeals, after it has taken the first step of deciding that the claims at issue must include a lever, then takes the concluding step—that the plunger is not an equivalent of the lever [R. Vol. V, p. 716], on the ground that the lever performs a double function [footnote 17, R. Vol. V, p. 715], that of operating both tappets 61 and 62. The Court ignores the fact that one of the objects of the invention recited [R. Vol. III, p. 509] in the patent in issue is "to make it possible for a single manual operation to tune either a radio set or a television set, or both; . . ." Therefore, it was understood that either one or both tappets 61 and 62 may be used.

But to be an equivalent, it is not necessary that the plunger perform *all* of the functions of the lever. See, for example, *Hobbs v. Beach,* 180 U. S. 383, at page 401:

> "The fact that the Horton device contains no mechanism for turning the strip into the inside of the corner, merely indicates that it does not perform all the functions of the Beach patent. But it is no less an infringement if it performs its primary function in practically the same way."

To permit the decision of the Ninth Circuit Court to stand uncorrected would invite serious misapplications of the law of reissue patents; for it would sanction the notion that claims added by a reissue must contain every element mentioned in any and all claims of the original, and that every element must be limited to the specific form described in the patent, even though such element is not stressed as essential in the original.

Conclusion.

It is respectfully submitted that the manifest errors appearing in the opinion of the Circuit Court of Appeals in its application of the law of reissues are compelling for the grant of this petition; and especially since the opinion is in conflict with a Second Circuit decision.

Respectfully submitted,

LeRoy J. Leishman,

By John Flam,

Counsel for Petitioner.

(2)

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v.

ASSOCIATED WHOLESALE ELECTRIC COMPANY, a corporation,

Respondent.

BRIEF OF RESPONDENT IN OPPOSITION TO PETITION FOR CERTIORARI

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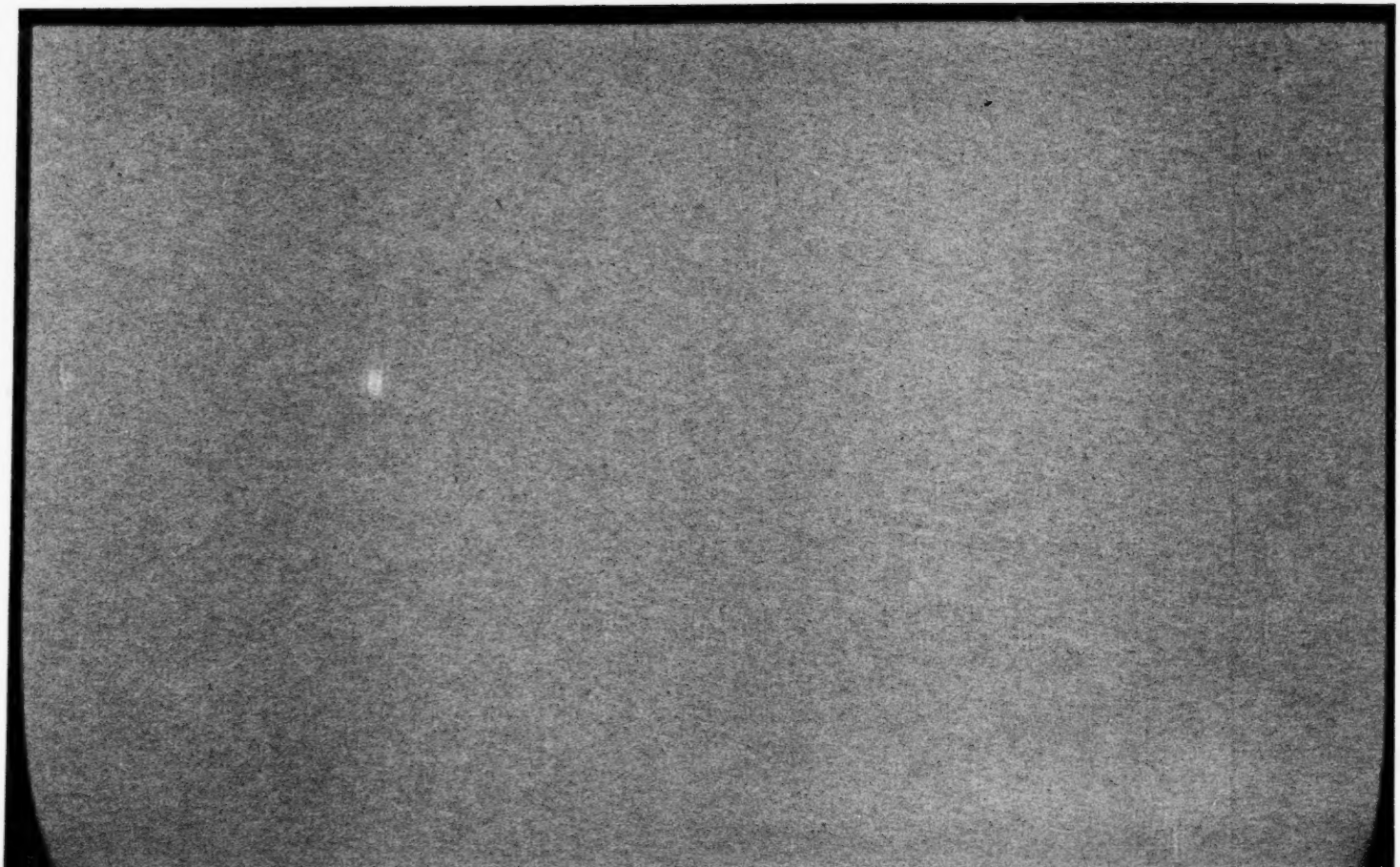

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No. 455

IN THE

Supreme Court of the United States

OCTOBER TERM, 1943

LEROY J. LEISHMAN,

Petitioner,

v.

ASSOCIATED WHOLESALE ELECTRIC COMPANY, a corporation,

Respondent.

BRIEF OF RESPONDENT IN OPPOSITION TO PETITION FOR CERTIORARI

STATEMENT

On February 15, 1938 letters patent No. 2,108,538 were issued to LeRoy J. Leishman. The patent disclosed a device for simultaneously tuning two radio receivers, a receiver for television and a receiver for sound. It consisted of a pair of rocking members, one of which was to be attached to the tunable element of the sound receiver, and the other of which was to be attached to the tunable element of the television receiver. A lever was provided, carrying a pair of adjustable tappets or cams. When the

lever was swung down to an operating position (as in Figure 2 of the patent), each cam contacted its individual rocker and turned it to an angular position predetermined by the setting of the cam.

Prior to the issuance of this patent, The Crosley Radio Corporation (now by change of name, The Crosley Corporation), of Cincinnati, Ohio, had manufactured and placed on the market radio receiving sets having push button tuning devices. (Rec. Vol. II, p. 367.) In the Crosley structure there was a rocker and there was a cam or tappet to move the rocker. (Finding 10, Rec. Vol. I, p. 35.) The tappet, however, was mounted upon a plunger, not upon a lever (Finding 14, Rec. Vol. I, p. 36); and in other respects also the structure was physically different from that disclosed in the patent.

When the patent issued, Leishman notified Crosley of infringement, and a conference was arranged at Cincinnati, Ohio. At this conference Leishman was informed that Crosley did not believe it infringed any claims of his patent, among other reasons, because *every claim was limited in terms to a lever operated device.* (Rec. Vol. I, p. 125, Rec. Vol. II, p. 479.)

Thereafter, Leishman filed an application for reissue of his letters patent, and on August 16, 1938 obtained a reissue in which five additional claims were added to the original six claims of the patent. One of his purposes[1] was to secure claims not limited to a lever, but broad enough to embrace a plunger.[2]

Still later, namely on January 16, 1939, Leishman disclaimed his original claim 5. He did this because a patent No. 2,072,897 to Marschalk had been called to his atten-

[1] In the reissue claims he also introduced for the first time the idea of *coaxiality* between the tappet and the rocker when the tappet fully engages the rocker. This was also not the invention intended to be claimed in the original patent. (Finding 18, Rec. Vol. I, p. 36.)

[2] This was admitted by Leishman. (Rec. Vol. I, p. 126.)

tion (Rec. Vol. I, p. 132), disclosing as a radio tuner the combination of a rocker, a lever, and an adjustable cam or tappet, and meeting every element of original claim 5. (Finding 15, Rec. Vol. I, p. 36.)

In the meantime, Leishman brought this suit in Los Angeles, California, against Associated Wholesale Electric Company, a distributor handling the Crosley line. The Crosley Radio Corporation defended its customer.

The District Court in its decision held that the claims expressed no invention and dismissed the bill. (Rec. Vol. I, pp. 28-39, 36 Fed. Supp. 804.)

An appeal was taken and the case was argued on its merits before the Ninth Circuit Court of Appeals. That Court, sua sponte, raised the question of the timeliness of the appeal, and dismissed the appeal as untimely. [Rec. Vol. IV, pp. 688-9, 128 F. (2d) 204.]

This matter was considered by the Supreme Court on certiorari, and the Ninth Circuit Court of Appeals was reversed (318 U. S. 203, 63 S. Ct. 543); but the case has not previously been in this Court on any question going to the merits of the controversy.

Upon remand to the Ninth Circuit Court of Appeals for consideration of the merits, that Court handed down an opinion [Rec. Vol. V, pp. 700-716, 137 F. (2d) 722] holding the claims not infringed if valid, and saying:

> "If they (the reissue claims in suit) do not include levers, the claims are not for the same invention as the original patent and hence are invalid. If they do include levers the claims are not infringed, for the accused device contains no lever." (Rec. Vol. V, p. 715.)

Earlier in its opinion the Court, after pointing out that original claim 5 was disclaimed in its entirety, said:

> "Hence both the original patent and the reissue must be construed as if claim 5 had never been included in either; for the disclaimer 'speaks from the date of the original patent.'"

ARGUMENT

The treatment of original claim 5 by the Ninth Circuit Court of Appeals is the mainspring of Leishman's Petition for Certiorari. Petitioner, while maintaining that the claims of an original patent should not be taken as the measure of what the patentee *intended* to claim, objects nevertheless to a consideration of the original patent as though it had never contained the disclaimed claim 5. The inference is that this claim, had it been considered, would have evidenced an intention on Leishman's part not to limit himself to a lever.

The inference is wrong; but the employment of it is a confession that nothing else, at least, in the document evidences such an intention.[3]

Leishman disclosed a lever and nothing else. Nowhere in his specification is there mention of any other element to carry the tappet. Nowhere in his specification is there a hint or suggestion that anything else could be used. Nowhere in his specification is there any teaching of the necessary mechanical changes which must be made if some other element were employed. *Nor did he claim anything but a lever-operated mechanism in his original patent.*

Claim 5 Was Limited to a Lever Like All the Original Claims

The original patent contained six claims. Every one of these claims, except claim 5, not only was limited to a double tuner (a device with two rockers for simultaneously tuning a radio set and a television set), but also used the word "lever." Claim 5 was Leishman's only original claim

[3] Leishman himself can find nothing in the patent. The words "a simple manually operated control" are not a disclosure of anything. They are merely another name for the only thing Leishman disclosed—a lever. Nor does a statement that modifications may be made in the invention without departing from its spirit, amount to a *disclosure*.

which would read on a single tuner—a device with only one rocker. In that claim he did not use the word "lever"; but he expressed his combination of elements in such terms as could read only on a lever-operated tuner.

Petitioner on pages 3 and 4 of his petition, analyzes claim 5 (giving reference numerals to the patent drawing), and states that the "means movable about a pivot" is the tappet 61. But the claim calls for, "means movable about a pivot and acting upon operation in one direction" to position the rocker in the act of tuning. The element stated by the claim cannot be the tappet alone, for the tappet does not respond to the language of the claim. The tappet cannot and must not be movable about its pivot during the act of tuning, for if it is, it cannot move the rocker. The only means which is or can be movable about a pivot during tuning is the lever assembly comprising the lever F moving on the pivot Q. Further, the claim calls for "a spring for holding *said means* in a normally inoperative position." The spring 73 engages the lever F, not the tappet 61. Moreover, if the means movable about a pivot is restricted to the tappet, then the claim states no operative combination, for it contains nothing to move the tappet, and nothing to lock the tappet so that it can position the rocker.[3a]

Respondent uses a sliding plunger; and a plunger is not a pivoted means.

Original claim 5 was thus as much limited to a lever as any of the other claims. Indeed, Crosley's explanation of this to Leishman was what led him, he said in testimony, to seek a reissue (Rec. Vol. I, p. 126).

[3a] Recognizing these difficulties, Leishman in such reissue claims as claim 7, said: "means *adjustably* movable about a pivot" (thus recognizing that the tappet must be locked during tuning), "and acting upon *bodily* movement" (thus recognizing that there is some unspecified element to hold and move the tappet). In such claims as reissue claim 9, he calls for "a manually movable operating means comprising an adjustably mounted positioning element."

The Ninth Circuit Followed the Industrial Chemicals Case

The Ninth Circuit Court of Appeals said in its opinion:

> "Thus a reissue patent must be for the same invention as the original patent. Otherwise it is invalid. An original patent and a reissue patent are not for the same invention unless what is covered by the reissue was disclosed in the original and was intended to have been covered and secured by the original. And this intention 'must appear from the face of the instrument'."

This seems a literal, if abridged, rendition of the words of the Supreme Court in *U. S. Industrial Chemicals, Inc.* v. *Carbide and Carbon Chemicals Corp.*, 315 U. S. 668, where it was said:

> "The question is whether, in the light of the disclosures contained in the two patents they are for the same invention. This Court has said that they are the same if the reissue fully describes and claims the very invention intended to be secured by the original patent; if the reissue describes and claims only those things which were embraced in the invention intended to have been secured in the original patent; if the broader claims in the reissue are not merely suggested or indicated in the original specification but constitute parts or portions of the invention which were intended or sought to be covered or secured by the original patent. The required intention does not appear if the additional matter covered by the claims is not disclosed in the original patent. . . . It must appear from the face of the instrument that what is covered by the reissue was intended to be covered and secured by the original."

The Court of Appeals held, on the subject of disclosure:

> "Thus the specification of the original patent discloses a combination comprising rockers, tappets and levers constituting what the specification calls a lever

assembly; and the claims of the original patent are for combinations each of which includes a lever or levers. *No leverless combination is disclosed . . . in the original patent. . . .*" (Italics ours, Rec. Vol. V, pp. 711-2.)

This holding appears to have been overlooked by Petitioner. It is not set up as error. Yet the defect of lack of disclosure on which to found leverless claims is itself fatal to the reissue, as held by this Court in the *Industrial Chemicals* case.

Harmless Error Is Not Ground for Certiorari

Rather, Petitioner is complaining of the Court of Appeals' disregard of original claim 5, as a failure to consider something which might have indicated an intention to claim. But since claim 5 was itself limited to a lever device, a consideration of it could not have altered the other part of the Court of Appeals' holding:

> "No leverless combination is . . . claimed in the original patent, nor does it appear from the face thereof that any leverless combination was intended to have been covered or secured thereby." (Rec. Vol. V, pp. 711-2.)

Since the Court of Appeals held there was no disclosure of a leverless device in the original patent, and since claim 5 could read on no operative structure save one employing a lever, a consideration of claim 5 by the Court of Appeals could have made a difference only in the language of its opinion, not in the substance. Such a "difference, not affecting the essential rights of the parties, is no ground upon which this court should exercise its discretionary power of issuing a writ of certiorari." *Smith* v. *Vulcan Iron Works, Norton* v. *Wheaton,* 165 U. S. 518, 526.

Refusal of Certiorari Does Not Establish a Principle of Law

This Court has many times said, as in *Altoona Publix Theatres* v. *American Tri-Ergon Corp.,* 294 U. S. 477, that

a disclaimer speaks from the date of the original patent. Whether there is any exception to this rule is perhaps an interesting speculation. It is difficult for us to see how a claim which has been disclaimed because the combination it expresses is completely old can properly be taken, in any event, as indicative of the breadth with which a patentee intended to express an element *in some other and different combination.* In this case claim 5 was disclaimed because the Marschalk patent showed everything called for by the claim. When Leishman reissued his patent he not only broadened the expression of the moving element to escape the limitation to a lever, but he began to claim for the first time coaxiality of the axes of the tappet and rocker, thus shifting his ground completely and basing his claim to originality on *coaxiality* in a combination otherwise admittedly old. Had claim 5 not been limited to a lever, it still could not have been indicative of any alleged breadth of Leishman's concept in some other and different "invention."[4]

But should the Supreme Court feel that a disclaimed claim can nevertheless be considered in determining the intention of an original patentee, still the circumstances of this cause indicate that a consideration of claim 5 could have made no difference in the final result.

The question, therefore, has here no standing on the merits of the controversy. Denial of certiorari imports no opinion by the Supreme Court on the merits of the case, and does not affirm it as a precedent. *United States* v. *Carver,* 260 U. S. 482; *Hamilton Brown Shoe Co.* v. *Wolf,* 240 U. S. 251; *Atlantic Coastline Railway Company* v. *Powe,* 283 U. S. 401.

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[4] Leishman never taught how coaxiality could be obtained in any but a lever-operated device; and in a plunger device it cannot be obtained in the same way. (Rec. Vol. II, pp. 412-414.)

There Is No Conflict of Decisions on Any Point Here Involved

It has been urged that there is a conflict between the decision of the Ninth Circuit Court of Appeals here and the decision of the Second Circuit in *Monogram Mfg. Co.* v. *Glemby Co.*, 136 F. (2d) 961. In that case the claims of the original patent related to a hair curler which had been shown with a spring in the drawings, and had been described with a spring in the specification. By reissue some claims were secured which omitted the spring. The spring, of course, was not necessary to the operation of the device.

The stated objects of the invention concerned themselves with functions to which the spring was not vital. While a spring had been shown and described, the specification *stated* that the patentee had no intention of confining himself to the details of the exemplary embodiments shown. One of the *original* claims (claim 4) was not limited to a spring. Moreover, there was in that case a very real showing of inadvertence, accident and mistake.

That a patentee, who, through inadvertence, accident and mistake, has claimed a mechanical device with the inclusion of an obviously unnecessary element, should be permitted by reissue to eliminate that element from certain claims, seems not unfair and is not in contravention of any of the pronouncements of this Court in the *Industrial Chemicals* case, in view of the circumstances found as facts by the Second Circuit. Especially so, since the patentee there was a Filipino, unfamiliar with the English language, who had tried to instruct his attorney to claim the invention both with and without the spring at the time the original application was filed, and who had furnished his attorney with a model not having the spring as well as with models having springs.

The difference here is manifest. Leishman is not trying by reissue to eliminate an unnecessary element from his claims. The lever is not a surplus element. If the lever is taken out of his disclosed structure, no operative combination is left. But having disclosed only a lever as the means for moving the tappet, having claimed only a lever, having made no hint in his specifications that anything else could be used, and having made no teaching *how* anything else could be used, he then sought, by reissue, claims broad enough to read on other undisclosed elements *as well as* the lever. If Leishman has actually succeeded in eliminating from any reissue claim the means to carry the tappet, then such a claim is invalid as covering an incomplete and inoperative combination.

The Question of Equivalency Is Not Involved

The Court of Appeals here held that levers and plungers are not equivalents, and this is complained of by Petitioner. There are many reasons why plungers are not the equivalent of levers, but the fact that lever tuners, which are bulky "cash register" devices, have not met with commercial success, whereas plunger tuners, which, because of the plungers, can be made tiny enough to be used in the smallest table model radios, have been accepted by the public, should be indicative. (See Fact Findings 9, 11, 13, and 14, Rec. Vol. I, pp. 35-6.)

Petitioner himself was unwilling to rely on the doctrine of equivalency, for when he reissued his patent, he took care to broaden the expression of the member which bore the tappet.

But in any case, concurrent findings by the District Court and the Court of Appeals that plungers and levers are not equivalents, give no basis for review by certiorari.

CONCLUSION

Since certiorari is discretionary, we believe we should call the Court's attention to these facts:

1. The District Court considered the reissue claims of the patent and found them void for want of invention. He found it unnecessary to pass upon any other defense.

2. The Court of Appeals held the reissue invalid if the claims read on other than a lever device, and since the claims would not be infringed if still limited to levers, it felt there was no need to go further.

There were other defenses.

3. The reissue patent is not for the same invention as the original, because in the reissue claims Leishman for the first time introduced the aspect of coaxiality, and began to claim that his invention lay in that feature added to a combination otherwise admittedly old. The District Court held:

> "The coaxial relation between the tappet and the rocker was not the invention intended to be secured in the original patent No. 2,108,538. The coaxial relationship was not claimed in the original patent, and is an afterthought in the reissue patent in suit brought into being to save the patent from the defense of anticipation." (Finding 18, Rec. Vol. I, p. 36.)

But the District Court felt it more fundamental that the claims, expressing coaxiality, nevertheless expressed nothing patentably new. He held them invalid for want of invention,[5] and dismissed the complaint. The Court of Appeals felt the patent was bad at the outset if, as contended, its reissue claims now read on a leverless device. There it stopped.

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[5] See Findings 19-23, Rec. Vol. I, p. 37. The District Court said:

"Coaxiality, which simply means being on-centers, is a mechanical principle hundreds of years old and must be considered in all machine designing when parts are to rotate together. . . . Coaxiality is old in the art, and the coaxial feature of the patent sued upon is the result of the use of mechanical skill."

4. The patent is also invalid because qualifying disclaimers, contrary to this Court's rule in the *Altoona Publix Theatres* case, were filed as to reissue claims 8, 9, and 10. This is apparent on the face of the document. No court has as yet passed upon it.

5. The facts set forth in our Statement (above) establish a clear situation of intervening rights under *Sontag Chain Stores Co. Ltd.* v. *National Nut Company of California,* 310 U. S. 281. No court has as yet passed upon it, excepting that the District Court found the facts (see Findings 7 and 8).

6. There was also a defense of non-infringement.

Should this Court accept the case on certiorari, Respondents would expect to urge these defenses. But it is also clear that this case does not present a basis for certiorari in the light of this Court's holding in *Keller* v. *Adams-Campbell,* 264 U. S. 314, 319, 320.

We submit that here the Court of Appeals has held a reissue patent invalid because it is not for the same invention as the original if, as contended, the claims have been broadened, because

(a) there is no disclosure in the original which would support such broader claims, and

(b) there is nothing in the original specification to indicate any intention to make such broader claims, and

(c) no such broader claims had been made in the original patent, irrespective of disclosure.

Further, the Court of Appeals, in holding that plungers and levers are not equivalents, has clearly held that Respondent is not following the teachings of the patent in suit, though an effort has been made by a reissue to expand the claims of the patent to cover what the Respondent does.

> "These passages read in connection with the original and reissued patents and the alleged infringement show that what the Courts really held was that de-

fendants were manufacturing a different invention from that of the plaintiff's, and so could not and did not infringe. Such an ordinary patent case with the usual issues of invention, breadth of claims and non-infringement, this Court will not bring here by certiorari unless it be necessary to reconcile decisions of Circuit Courts of Appeal on the same patent." (*Keller* v. *Adams-Campbell,* supra.)

Thus, it seems a tenuous ground on which to base a request for certiorari, that the Court merely neglected to consider one of the claims under item (c) above, because that claim had been disclaimed, when an examination of it shows that this claim also was a similarly limited claim, and when the record shows that knowledge of this was one of the things motivating Petitioner's application for reissue.

Respectfully submitted,

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IN THE

Supreme Court of the United States

October Term, 1943

No. 455

LEROY J. LIEBERMAN,

Petitioner,

vs.

ASSOCIATED WHOLESALE ELECTRIC COMPANY, a corporation,

Respondent.

PETITION FOR WRIT OF CERTIORARI

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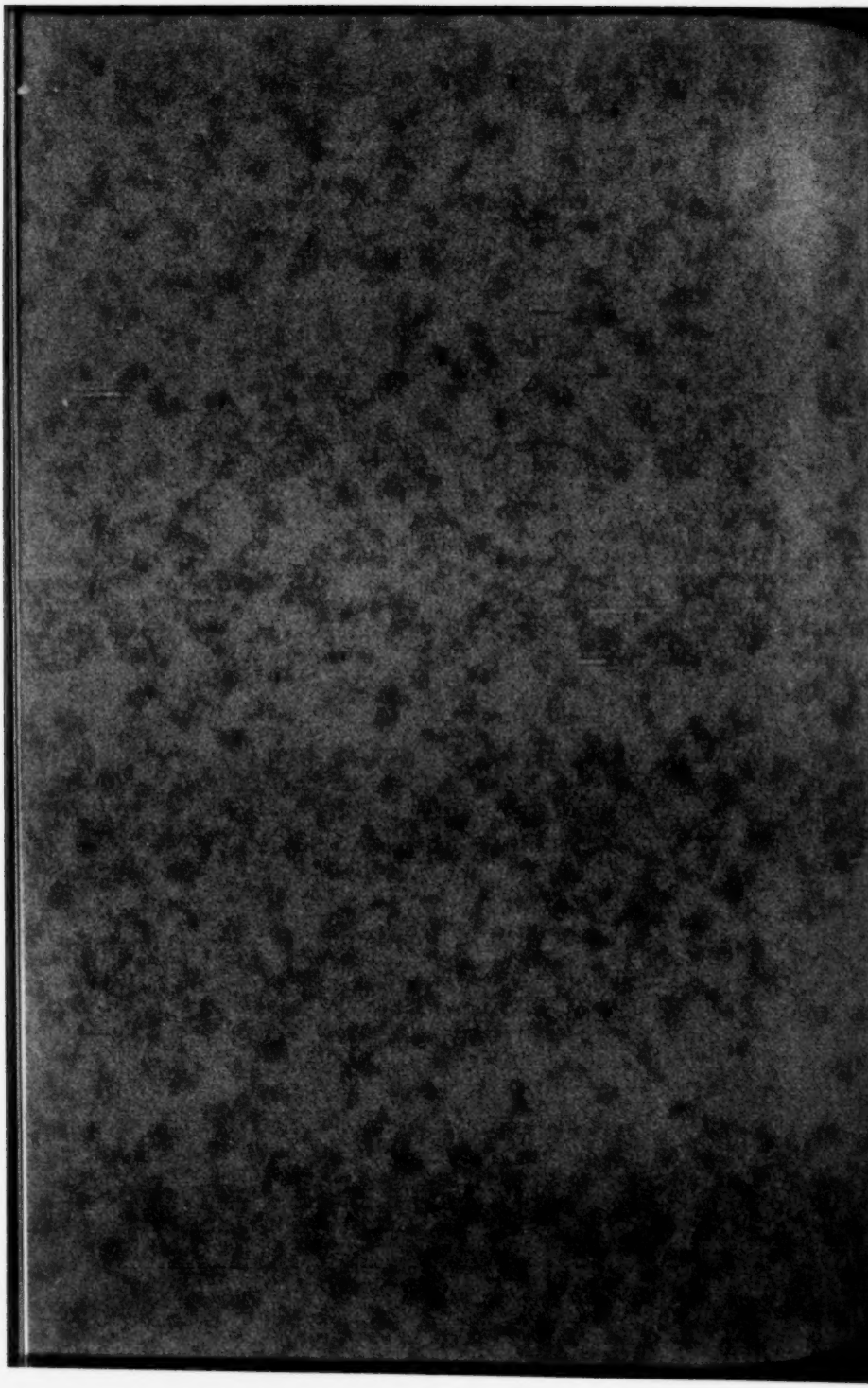

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IN THE

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October Term, 1943
No. 455.

LEROY J. LEISHMAN,

Petitioner,

vs.

ASSOCIATED WHOLESALE ELECTRIC COMPANY, a corporation,

Respondent.

REPLY BRIEF.

Introduction.

The Petition for a Writ of Certiorari filed by petitioner on October 25, 1943, was based primarily upon two grounds: first, that there was a conflict between the Ninth Circuit decision in the present case and that of the Second Circuit in the case of *Monogram Mfg. Co. v. Glemby Co., Inc., et al.*, 136 F. (2d) 961; and second, that this Honorable Court has never passed upon whether, in determining what a patentee intended to cover *in his original patent* it is proper for a court to place an artificial construction upon such original patent by purposely treating it as if one

of its claims had never been included because the claim was disclaimed from the reissue.

Respondent's brief makes no attempt to defend the ignoring of an original claim on such grounds, but tries to minimize the importance of the principle of patent law that is involved by stating (p. 8): "Whether there is any exception to this rule (that a disclaimer speaks from the date of the original patent) is perhaps an interesting speculation." Respondent then argues that even if the Circuit Court had considered original claim 5 in comparing the original and reissue patents, the result would have been the same, and that claim 5, like the other original claims, includes a lever.[1]

In interpreting claim 5 in a manner to make it appear that petitioner regarded a lever as an essential means for mounting and operating the tappet, respondent has ignored a part of the claim with which its interpretation cannot be reconciled. Inasmuch as respondent bases its opposition to the granting of the petition chiefly on such interpretation of claim 5, petitioner feels that the demonstrable errors in respondent's misconstruction should be pointed out; and this belief is the chief reason for filing this reply brief.

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[1]Evidently the Circuit Court did not think so, for it took pains to point out that in arriving at its decision it had ignored original claim 5.

Claim 5 Did Not Include a Lever as an Element.

Respondent tries to make it appear that the term "means movable about a pivot" applies to the lever F. This full term from the claim reads: "means movable about a pivot and acting upon operation in one direction (downward) to slidably engage either arm of said rocker and push it in one direction to an angular position at which the movement of said rocker is arrested by the collision of said means and the oppositely moving other arm of said rocker." This language cannot possibly refer to the lever, for it is the tappet, and not the lever, that engages either arm of the rocker and pushes it; and it is also the tappet, and not the lever, with which the other arm of the rocker collides.

It is also significant that none of the other claims of the patent refer to the lever F as being "pivoted" or "mounted upon a pivot," and that in selecting the terminology to be applied to the mounting of the various members, the term "pivoted" is reserved as one of the alternative ways of describing the mounting of the rocker, the locking lever 66 that is pivoted upon lever F, and the tappet itself. In claims 1 and 2 [R. Vol. III, p. 510], the tappets are referred to as "adjustable members *pivoted.*" In claim 3, the tappet is "pivotally mounted"; but in *none* of the claim is the lever F referred to in such a manner.

In a further misconstruction to make "the means movable about a pivot" appear to be the lever F, respondent's brief (p. 5) says: "The tappet cannot and must not be movable about its pivot during the act of tuning, for if it

is, it cannot move the rocker. The only means which is or can be movable about a pivot during tuning is the lever assembly comprising the lever F moving on the pivot Q."

There is nothing about the term "means movable about a pivot" that says such movement takes place during tuning. The tappet must be movable about its pivot for adjustment purposes.

In its concluding item of misconstruction (also p. 5), respondent says: "Further, the claim calls for 'a spring for holding *said means* in a normally inoperative position.' The spring 73 engages the lever F, not the tappet 61."

The claim does not say the spring *engages* the "means movable about a pivot." Inasmuch as the spring does not need to be attached to the tappet, the spring is merely defined as "for holding said means in a normally inoperative position." This is exactly what the spring does. The tappet must normally be in an inoperative position out of engagement with the rocker, and the spring is for holding it there.

It should be clear from what has been said in this and the previous briefs that the Circuit Court could not have stated that "No leverless combination is disclosed or claimed in the original patent" if claim 5 had been taken into consideration, and that such a holding is explained by the Circuit Court's own statement that "the patent is construed as if claim 5 had never been included therein."

The principle of patent law here involved has never been passed upon by this Honorable Court, and the Circuit

Court's ignoring of this claim in determining petitioner's intent is an unwarranted misapplication of the doctrine of the *Altoona* case, as pointed out in the petition.

Regarding the Equivalency of a Lever and a Plunger.

Respondent's statements as to the equivalency of a lever and a plunger apparently have no bearing upon the grounds advanced by petitioner for the granting of the petition and are pertinent only to the ultimate matter of whether there is infringement of the claims that include the manual operating member as an element of the combination. (Claims 7 and 8 are drawn to what the District Court called "the essential elements" and do not include the manual operating member as an element of the combination.) Petitioner will therefore merely point out at this time that respondent has imported a much broader scope into the Circuit Court's statement as to the equivalency of the lever and a plunger than the decision justifies.

Says respondent's brief (p. 10): "The Court of Appeals here held that levers and plungers are not equivalents, and this is complained of by Petitioner. There are many reasons why plungers are not the equivalent of levers . . ." On the same page, respondent's brief further says: "But in any case, concurrent findings by the District Court and the Court of Appeals that plungers and levers are not equivalents, give no basis for review by certiorari."

Neither the District Court nor the Court of Appeals ruled that levers and plungers *per se* are not equivalents.[2]

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[2]As the District Court pointed out (see the petition, bottom page 4 to top page 5), the rocker and tappet and their coaxial relationship in the tuned-in position are "the essential elements in the plaintiff's structure." The manual operating member (lever or plunger) merely serves to guide and transmit motion to the tappet. A plunger or lever thus serves the same function in the tuning device that a handle serves on a pump, and the Circuit Court did not dispute their equivalency *per se*, but differentiated them because of the number of tappets operated. Inasmuch as it has been shown from the patent that petitioner intended to use either one or two tappets optionally, respondent's contention that its use of a plunger relieves it of infringement (respondent's brief, p. 2) is like a pump manufacturer contending that it has avoided infringement of a pump patent by using a different type of handle—by using a plunger instead of the lever type of handle to operate the mechanism.

Respondent is wrong in inferring that the Circuit Court of Appeals held that in every instance levers and plungers are not equivalents. On the contrary, every court that has actually considered the matter as far as petitioner has been able to learn has held that they *are* equivalents.

In *Blake v. Robertson*, 94 U. S. 728, 732, 733, 24 L. ed. 245, this Honorable Court held that a pump and piston (plunger) were the mechanical equivalents of a vibrating arm (lever), toggle joint, and other mechanical devices, used in transmitting power.

The equivalency of such members is also asserted in *Bundy Mfg. Co. v. Detroit Time-Register Co.*, 94 F. 524 (C. C. A. 6), in which the court, at page 538, said.

> "* * * Whether his key actuated the feeding and printing mechanism by being turned (as is a lever) or pushed (as by a plunger) is not of the essence of the invention. Pushing keys (plungers) setting in motion bolts and other mechanisms were old, and but the equivalents of keys which did the same thing by turning."

In *New Departure Bell Co. v. Hardware Specialty Co.*, 69 F. 152 (C. C., N. J.), the court adjudicated specifically that a *push bar* is the equivalent of a *lever* (p. 156):

> "* * * In this patent is to be found all the elements of this Rockwell claim, combined and operating in substantially the same way and for the same purpose, with the single exception that the *operative push bar* of the French patent—*of which the lever of the claim is the manifest mechanical equivalent*—has a vertiaction instead of a horizontal movement." (Emphasis added.)

The District Court did not take up this matter, and the Court of Appeals merely held that respondent's plungers were not the equivalent of petitioner's levers because, said the Court of Appeals [R. Vol. V, pp. 715-716]: "The plungers perform a part, and only a part, of the function performed by appellant's levers F and 66. The part so performed is not performed in the same way, or in substantially the same way." In its footnote 17, the Circuit Court explains this holding by saying: "Appellant's levers have a double function—that of operating the tappet 61 and that of operating the tappet 62. The latter function is not performed at all in the accused device."

The distinction drawn by the Circuit Court was thus not directed to plungers and levers *per se*, but to the fact that petitioner's operating member operates two tappets while that of respondent operates only one. This was the only reason advanced by the Circuit Court for its holding that the two structures were not equivalents, and petitioner complained that this was not a valid distinction because the patent specifically states that one of the objects is "to make it possible for a single manual operation to tune either a radio set or a television set, or both." The patentee thus contemplated using either one or two tappets, depending upon whether the manufacturer desires to tune only a radio set or a television set, or both. Furthermore, it cannot be disputed that the device was claimed with only a single tappet *in the original patent* in claim 5 and in claims 7 to 11 of the reissue patent, as well as in reissue claim 5 which was later disclaimed. Respondent's use of

a single tappet is thus exactly what the patent specifically provided for.

Even if the patent had not expressly made this provision, the use of a single tappet would not relieve respondent of his responsibility according to this Honorable Court's doctrine in *Hobbs v. Beach,* quoted on page 22 of petitioner's brief in support of his petition.

The Conflict Between the Ninth and Second Circuit Courts of Appeal.

The conflict between the opinions of the Ninth and Second Circuit Courts of Appeal, which petitioner believes is a sufficient reason by itself for granting the petition, is glaringly manifest on page 9 of respondent's brief where respondent justifies the Second Circuit decision respecting precisely the same issues and a set of facts that are about as closely parallel as they could possibly be.

Says the respondent:

> "* * * In that (the Glemby) case the claims of the original patent related to a hair curler which had been shown with a spring in the drawings, and had been described with a spring in the specification. By reissue some claims were secured which omitted the spring. The spring, of course, was not necessary to the operation of the device."

In the instant case, the original patent related to a tuner which had been shown with a lever in the drawings, and had been described with a lever in the specification. By reissue some claims were secured which like original claim 5 omitted the lever. The lever, of course, was not an

essential means of operating the tappet, as respondent itself has shown by its use of a well-known mechanical equivalent; in fact, long before the Supreme Court rendered its *U. S. Industrial Chemicals* decision and discussed *essential* elements, the District Court in the present case, in discussing respondent's use of petitioner's combination, saw fit to enumerate what it called "the essential elements," and in this enumeration the lever was not included.

"The stated objects of the invention," continues respondent's discussion of the *Glemby* case on page 9, "concerned themselves with functions to which the spring was not vital. While a spring had been shown and described, the specification *stated* that the patentee had no intention of confining himself to the details of the exemplary embodiments shown. One of the *original* claims (claim 4) was not limited to a spring. Moreover, there was in that case a very real showing of inadvertence, accident and mistake."

In the instant case the stated objects of the invention likewise concerned themselves with functions to which a lever was not vital, as pointed out on page 11 of the petition and in footnote 6 on page 13. While a lever had been shown and described, the specification *stated* that "modifications may be made from the automatic tuning systems and devices herein described without departing from the general nature and purpose of the invention." One of the original claims (claim 5) was not limited to a lever. Moreover, there was in this case a very real showing of inadvertence, accident and mistake in that no single tappet and rocker claims like claim 5 had been included that expressed the coaxial relationship shown in the drawings of the original patent and stressed on page 2, column 1, lines 30 *et seq.* thereof, although this relationship had been ex-

pressed in other language in claims 1 and 2 by setting forth the relations between the pivot points of the tappets and the axis of the rocker with respect to the fulcrum of the operating lever.

In the concluding paragraph on page 9 respondent says:

> "That a patentee, who, through inadvertence, accident and mistake, has claimed a mechanical device with the inclusion of an obviously unnecessary element, should be permitted by reissue to eliminate that element from certain claims, seems not unfair and is not in contravention of any of the pronouncements of this Court in the *Industrial Chemicals* case, in view of the circumstances found as facts by the Second Circuit."

That the instant patentee who had a claim in his original patent directed to the essential elements and therefore omitting the lever, should be permitted in his reissue likewise to omit the lever from the new claims, seems also *not unfair;* BUT IN HIS CASE THE CONFLICTING OPINION OF THE NINTH CIRCUIT COURT SAYS THAT IF THE CLAIMS "DO NOT INCLUDE LEVERS, THE CLAIMS ARE NOT FOR THE SAME INVENTION AS THE ORIGINAL PATENT AND HENCE ARE INVALID."

Conclusion.

Clearly there is a conflict between the decisions of these two Circuit Courts of Appeal that constitutes ample grounds for the granting of the petition; and, moreover, the action of the Ninth Circuit Court of Appeals in determining intent by construing an original patent as if one of its claims had never been included, on the ground that it was later disclaimed from the reissue, is an unwarranted and artificial extension of the doctrine expounded in the *Altoona* case that can have serious consequences.

In the instant case, this ignoring of an original claim in determining the intent of the patentee, has already had *two* serious consequences: First, it nullified the effect of part of the evidence which showed that the patentee had no intention of limiting himself to a lever as an operating member and it led the Circuit Court to decide that the reissue was not for the same invention; and second, it nullified the effect of part of the evidence which showed that the patentee intended the operating member to carry either one or two tappets, and was a factor in leading the Circuit Court to conclude that levers and plungers, which are otherwise equivalents, were not equivalents in this case because the operating member of the accused device operates a single tappet.

It is respectfully submitted that the conflict with the Second Circuit Court of Appeals on the one hand, and the distortion of the *Altoona* doctrine on the other, are matters that call for the exercise by this Court of its supervisory powers by granting the petition for a writ of certiorari and thereafter reviewing and reversing the decision complained of.

Respectfully submitted,

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By John Flam,

Counsel for Petitioner.

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IN THE

Supreme Court of the United States

October Term 1943.

No. 455

LEROY J. LEISHMAN,

Petitioner,

vs.

ASSOCIATED WHOLESALE ELECTRIC COMPANY, a corporation,

Respondent.

PETITION FOR REHEARING.

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LEROY J. LEISHMAN,

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ASSOCIATED WHOLESALE ELECTRIC COMPANY, a corporation,

Respondent.

PETITION FOR REHEARING.

Your petitioner respectfully requests that his petition for a writ of certiorari, denied December 6, 1943, be reconsidered because of the importance and far reaching effect of the principles of patent law involved—principles upon which this Honorable Court has never passed.

More succinctly stated, the question presented by the Ninth Circuit Court decision in the instant case, and posed in the original petition, are:

1. Can a court purposely delete a portion of the original patent before comparing it with the reissue to determine whether the two are for the same invention?

2. Is the Second Circuit Court of Appeals right in holding that reissue claims may omit an element not stressed as essential in the original patents, or is the Ninth Circuit Court of Appeals right in holding that the reissue is not for the same invention unless its

claims include all the specific elements that may be found in the original patent and claims, even though one of the elements was not stressed in the original patent as essential to the invention and was, in fact, omitted from one of the original claims?

Regarding the Matter of Deleting a Part of the Original Patent Before Making the Comparison.

In its decision in *U. S. Industrial Chemicals, Inc. v. Carbide and Carbon Chemicals Corp.*, 315 U. S. 668, this court reiterated the long established doctrine that whether a reissue is for the same invention as the original is to be determined by a comparison of the two documents themselves, and that "It must appear from the face of the instrument that what is covered by the reissue was intended to be covered by the original."

In purposely deleting a portion of the original patent before making this comparison, the Ninth Circuit Court of Appeals has done an unprecedented thing. Instead of judging what appears from the face of the two instruments as they issued from the patent office, the Appellate Court admittedly marred the face of the original patent and then concluded that the two documents did not look the same.

The Ninth Circuit Court did this as a result of a misinterpretation or misconception of this Honorable Court's decision in *Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U. S. 477. In that decision, this court said that a disclaimer "speaks from the date of the original patent."

In using that statement as its authorization to construe the *original* patent as if it had never included claim 5

because it was later disclaimed from the reissue after the issuance of the letter, the Ninth Circuit Court of Appeals overlooked two important things about the *Altoona* decision:

a) The Supreme Court obviously meant that *so far as holding an infringer is concerned,* the disclaimer speaks from the date of the patent itself. The statement in the *Altoona* case cannot be applied to the matter of *original intent* and then construed to mean that the patentee never intended to make the disclaimed claim in the first place.

b) In its *Altoona* decision, the Supreme Court was dealing with an *original* patent, not with a *reissue.* The statement that the disclaimer "speaks from the date of the original patent" therefore meant that the disclaimer speaks from the date of the patent to which it is attached, and it did not mean that a disclaimer of a *reissue* claim must be applied to the original patent when resurrecting it to determine the patentee's *original* intent.

As pointed out in the petition and in the reply brief, the Ninth Circuit Court of Appeals in the instant case cited the *Altoona* decision as authority for construing the original patent as if it had never included claim 5, which was confined to the essential elements of the invention and did not include a lever. Based upon its deletion of this claim and summing up its consideration of the *other* original claims, the Ninth Circuit Court of Appeals was able to say: ". . . the claims of the original patent are for combinations each of which includes a lever or levers.[13]" Its footnote 13, here referred to, analyzed claims 1, 2, 3, 4 and 6, and ignored claim 5 for the reasons

which the decision had previously explained, and which are here complained of. The Court of Appeals then concluded: "If they (the reissue claims) do not include levers, the claims are not for the same invention as the original patent and hence are invalid." (Citing the Supreme Court *U. S. Industrial Chemicals* decision.)[1]

This misapplication of the *Altoona* decision is a very serious one. As long as it stands uncorrected, no patentee can safely disclaim a broad claim from a reissue patent that appears in his original patent without placing the validity of his reissue patent in jeopardy.

If the disclaimed reissue claim must be stricken from the original patent when comparing the two documents to determine whether they are for the same invention,

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[1]Respondent's brief urged that the petition should not be granted on the ground that the decision would have been the same even if claim 5 had been considered. To support this contention, respondent misconstrued the claim in its brief. That respondent's interpretation cannot be reconciled with the language of the claim was thoroughly brought out in petitioner's reply brief (pp. 4-5), to which reference is respectfully requested.

Even had the Circuit Court interpreted claim 5 in the manner recommended by the respondent, the consideration of this claim nevertheless would have avoided the holding that respondent's plunger is not the equivalent of petitioner's lever, for the only reason the court assigned for this holding was that respondent's plunger operates only one tappet whereas petitioner's lever operates two. No matter what genius respondent may show in misconstruing claim 5, it cannot import two tappets into the claim, nor two rockers. A consideration of this claim, even as misinterpreted by the respondent, would thus have shown that petitioner intended his invention to be used with a single tappet and rocker "to tune in either a radio set or a television set," as set forth in the objects. No distinction between the lever and plunger as equivalents could then have been drawn.

For further information on this point, the court is respectfully referred to pages 5, 6, 7 and 8 of petitioner's reply brief, including especially the last half of the footnote on page 6.

then such deletion, as in the instant case, the two documents will of course be dissimilar on their face. The presence of a broad claim in an original patent constitutes most excellent evidence of the patentee's intention to claim his invention broadly without tying himself down to the exact embodiment shown, and therefore should not be ignored. Particularly is this true if the claim is drawn to the essential elements of the invention *per se* without including auxiliary parts in which the essence of the invention does not lie.

The Supreme Court granted petitioner's request for a writ of certoirari in this case on a previous occasion because of the possible consequences of the decision of the Ninth Circuit Court of Appeals to the effect that a motion under Rule 52 (b) did not extend the time for filing an appeal. The question now presented is much more serious in its possible effect upon future litigants than the earlier one involving Rule 52 (b). Had the Ninth Circuit's holding regarding this rule not been reversed, future litigants could appeal within three months of the original judgment; but future litigants have no alternative by which to escape the consequences of the Ninth Circuit's latest decision in this case. Hundreds of reissue patents that duplicate certain original claims are now in force, and others will be granted in the future. When it becomes necessary to disclaim from any of these reissues one of the broad claims carried over from the original patent, the patentee in every such instance will be faced with a dilemma that cannot be resolved. If he disclaims the claim, it will "speak from the date of the original," and the construing of the original as if the claim had never been included will make it appear that the patentee had no intention of making a broad claim in the original

patent; and the presence of other broad claims properly not disclaimed from the reissue will bespeak a different invention from the artificially construed original document, with the result that the reissue will be invalid. So on this ground it would appear that he should not enter the disclaimer. Yet if he does not disclaim the broad claim to which he has found he is not entitled, his patent will be invalid through failure to disclaim, for it has been uniformly held by the courts that such failure invalidates the whole patent.

This decision of the Ninth Circuit Court of Appeals thus makes it unsafe for any patentee to disclaim from a reissue patent any broad claim that has appeared in the original.[2]

And there is nothing hypothetical or suppositional about this statement. In the instant case, all the patentee's rights to any invention that resided in his rocker and tappet elements and their relationships *per se*, have been wiped away by the Appellate Court. This was done by its holding that as a result of his disclaimer of claim 5 from the reissue patent, the claim must be deleted from the original patent also, for the court used this deletion to reach its conclusion that the patentee never intended to claim any invention in respect to these essential elements unless they were operated by a lever, and that if the

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[2]It might be suggested that he obtain a second reissue, in order to rid himself of the unwanted claim. But this cumbersome method is a poor substitute for the expeditious remedy provided by the disclaimer statute. If disclaimer statute should thus be limited, then the Supreme Court should pass upon the point. On the other hand, if the disclaimer method is proper, the 9th Circuit Court of Appeals should be reversed.

reissue claims "do not include levers, the claims are not for the same invention as the original patent."

The instant decision of the Ninth Circuit Court of Appeals thus not only makes it possible to place an artificial interpretation upon a patentee's original intent, but also creates a situation that is incompatible with a patentee's statutory right to disclaim. Surely this state of affairs justifies the granting of the petition for a writ of certiorari.

But there are yet other grounds for such action.

The Conflict With the Decision of the Second Circuit Court of Appeals Confuses the Law With Respect to Reissues.

The conflict between the instant decision and the cited decision of the Second Circuit Court of Appeals involves interpretations of this Honorable Court's decision in the *U. S. Industrial Chemicals* case that broadly affect the reissue statute and the whole doctrine with respect to reissue patents.

In *Milcor Steel Co. v. George A. Fuller Co., et al.*, 316 U. S. 143, this Honorable Court said at page 144: "We granted certiorari . . . because of an alleged conflict with decisions on the question in other circuits," the alleged conflict being with the *Payne Furnace* decision of the Ninth Circuit. As in the instant case, the same patent was not involved in both circuits, but the petition was granted because of the importance of the doctrine concerned.

The instant conflict is far more than an alleged one. There is an actual conflict on an important point of law. If the Ninth Circuit interpretation of the Supreme Court's *U. S. Industrial Chemicals* decision is to prevail, then—

a) No patentee can safely obtain a reissue containing claims limited to the essential elements of his invention.

b) The right to obtain a broadening reissue, clearly permitted by the statute, will be nullified.

In *Monogram Mfg. Co. v. Glemby Co., Inc.*, 136 F. (2d) 961, the Second Circuit Court of Appeals followed the Supreme Court's decision in the *U. S. Industrial Chemicals* case, and made the omission of an element from the reissue contingent upon whether the element had been stressed as essential in the original patent.

In the instant case, the decision of the Ninth Circuit Court of Appeals that applicant's reissue claims are not for the same invention unless they include levers, was not in any way made contingent upon any statement in the original patent that the lever was an essential part of the invention. The court merely pointed out that the invention is not shown nor described without a lever, and that if claim 5 is ignored, all the remaining claims include levers. The court then erroneously concluded that the reissue claims must therefore include levers in order to be valid.

Broadening reissues[3] are obtained by omitting from the claims elements that were included in the original claims but which are not a part of the invention *per se*. *If the Ninth Circuit, instead of the Second Circuit, is to be followed, this can no longer be done.*

As a result of the conflicting opinions between these two circuits, the law is confused; and no one knows now whether elements that are not a part of the invention *per se* can be omitted from reissue claims, nor is it certain whether broadening reissues are still permissible.

Petitioner urges that the Supreme Court should remove this uncertainty.

This conflict between circuits constitutes a second reason, totally independent of the first, why the petition for a writ of certiorari should be granted.

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[3] If claim 5 is considered as having been a part of the original patent, the instant reissue is not a broadening one, for no operating element of any kind was included in the claim. The qualifying limitations added to the language of claim 5 in claims 7 and 8 serve to narrow the claim, as does the addition of an operating member in claims 9, 10 and 11. If the patentee's original intention is supposed to be judged by pretending that claim 5 was never a part of the original patent, then the matter of whether the present reissue is a broadening or a narrowing one would have to be determined by comparing the other original claims with those added in the reissue. However, the matter of whether the present reissue is a broadening or a narrowing one is of no moment in the present case.

Additional Informal Grounds.

The two grounds on which the petition was based, and which have been more fully discussed herein, are of course within the scope of Rule 38 of this Honorable Court. However, this Court has, on occasion, reviewed Circuit Court patent decisions for reasons not within the rule when it has appeared impractical for the patentee to secure a decision in another circuit within the forseeable future, if at all.[4] In the present case, there are two reasons of a similar nature why the petition should be granted.

Although petitioner believes that the grounds already stated are of more than sufficient importance and seriousness to justify the granting of the petition, it may be well here to discuss the special reasons why the instant petitioner should not be required to await a decision on this same patent by another circuit.

The First Special Reason.

In the year 1938, the reissue patent involved in this suit was widely infringed. That very year, your petitioner filed the present suit against the respondent, a jobber for the Crosley Corporation, the first infringer [R. Vol. I, p. 5]. Petitioner was unable to get the suit placed on the calendar until the spring of 1940, and then, at the request of the judge to whom the case was assigned, both litigants consented to have the case put over until the

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[4]*Mackay Radio and Telegraph Company, Inc. v. Radio Corporation of America,* 306 U. S. 86; 59 S. Ct. 427; 83 L. Ed. 506.

Paramamount Publix Corporation v. American Tri-Ergw Corporation, 294 U. S. 464; 55 S. Ct. 449; 79 L. Ed. 997.

fall term. The case came to trial on October, 1940, and the opinion is dated January 29, 1941 [R. Vol. I, p. 32]. The decision was appealed; but as this Honorable Court knows, the appeal was dismissed for reasons which this court held to be "artificial and untenable." As a result of this delay, the Circuit Court decision was not rendered until August of this year, 1943. If your petitioner now has to await a decision from another circuit in another suit, the statute of limitations will render it impossible to make the ultimate decision effective against still other 1938 infringers.

On only one occasion has your petitioner been responsible for any delay during the five-year period that has elapsed since the present suit was brought, and that was a ten-day delay necessitated because of counsel's absence from the city in connection with another case. Your petitioner has thus shown diligence in protecting his patent rights, yet he has gotten only this far; and he should not be required to begin all over again and have his rights to recover wiped away in the meantime by the statute of limitations. It might be suggested that there is yet time to file these suits. This is probably true, but the courts now insist that such cases be tried promptly, and it would be out of the question to do that, as there are almost a score of 1938 infringers in various circuits.

Secondly, Petitioner Has Never Had a Chance to be Heard on the Points Now Decided Against Him.

The second reason that is peculiar to the present case involves the obvious right of any litigant to be heard on any grounds on which a case is decided against him. The ground that the reissue claims in suit are not for the same invention as the original patent unless they include levers, was never advanced by anyone until the Circuit Court advanced it in its decision.[5] The contributory argument that an original claim that has been disclaimed from the reissue cannot be taken into consideration when examining the original patent to determine what the patentee intended to cover, was likewise never raised until this last Circuit Court decision was rendered. Your petitioner has thus had no chance to be heard on either of these points. If the Supreme Court does not grant the petition, the instant litigant, five years after the filing of his suit which has been diligently prosecuted, will have had his claims against the respondent wiped away on grounds on

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[5]It is true that respondent urged the stock defense against reissue patents that the reissue was not for the same invention as the original, but respondent based this defense upon the fact that petitioner added to his reissue claims the limitation that the tappet and rocker must be shaped and arranged so that the axis of the one is coaxial with the axis of the other in the tuned-in position. This feature was shown in the original drawings and disclosed in the original specification, and language directed to structural features that attain this coaxiality was included in certain of the original claims. The Court of Appeals did not hold with the defendant on this score, but advanced a totally new ground for contending that the reissue was not the same invention—namely, that the reissue claims must include levers in order to be valid. This ground was not included in the defenses raised by the respondent; it was never raised by the District Court; it was never raised in any brief until after the Circuit Court rendered its decision; and it was never raised by the Circuit Court in any hearing.

which he has never been given an opportunity to be heard. This is hardly in keeping with American ideals of justice. But the injustice can be removed by the exercise by this court of its discretionary powers.

Your petitioner thus earnestly urges that his petition should be reconsidered and granted.

Respectfully submitted,

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JOHN FLAM,

Counsel for Petitioner.

Certificate.

This petition for rehearing is presented in good faith and not for delay.

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JOHN FLAM,

Counsel for Petitioner.